

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-3, 5- 17, 19-24, and 26-28 are pending in this application. Claims 4, 18, and 25 were previously canceled without prejudice or disclaimer.

The outstanding Office Action presents a rejection of Claims 1, 5, 15, 19, 22, and 26 as being anticipated by Maeda et al (U.S. Patent No. 6,005,834, Maeda), and a rejection of Claims 2, 3, 6, 7, 16, 17, 20, 21, 23, 24, 27, and 28 as being unpatentable over Maeda in view of Funada (U.S. Patent No. 4,730,294) under 35 U.S.C. § 103(a).

Initially, Applicants gratefully acknowledge the indication in the outstanding Office Action that Claims 8-14 are allowable over the prior art.

As was noted in the preliminary amendment filed on April 18, 2003, Claims 4, 18, and 25 were canceled and their subject matter was included in respective independent Claims 1, 15, and 22 to effectively rewrite Claims 4, 18, and 25 in independent form. As further indicated in this preliminary amendment, this was done to overcome the objection in the Office Action mailed November 18, 2002, that only objected to Claims 4, 18, and 25 as being dependent upon a rejected base claim and further stated that Claims 4, 8, and 25 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Further in this regard, the Office Action mailed November 18, 2002, stated the following "Examiner's statement for the indication of allowable subject matter:"

As in Claims 4, 18, and 25, the prior art of record fails to teach or fairly suggests an optical information recording/reproducing apparatus having an optical pickup for making a light beam emitted from a light source incident on a recording medium via a two-group objective lens so as to record or

reproduce optical information on or from said recording medium wherein a cycle of the cyclic change in a distance between said first lens and said second lens is longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens.

Thus the Examiner then recognized then that the actual claim limitation required that there must be “a cycle of the cyclic change in a distance between said first lens and said second lens” and that this “cycle” of the distance that is created between the first lens and the second lens must be “longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens.” These statements further clearly require that the change in distances has to relate to cyclic movement where a “cycle” clearly relates to a periodic cycle that must repeat over time if the required plain meaning of “cycle” to the worker of ordinary skill in the art is used, as it must be. See In re Cortright, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999) (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.”).

Having stated the relevant claim limitation in a manner recognizing that more than a simple distance between lenses is recited by the language “wherein a cycle of the cyclic change in a distance between said first lens and said second lens is longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens,” it is believed to be clear error to now ignore the very language of the claims previously stated to be allowable subject matter.

In this last regard, the new rationale offered to support the rejection of these claims as being anticipated by Maeda is that “one of the lenses 36 or 37 moves a distance d_1 , the change in a distance d_2 between the first lens and the second lens 37 is the distance $d_2 + d_1$ and therefore $d_2 + d_1 > d_1$.” However, the claim language in question does not simply state

that a lens is moved from one position separated from another lens to a new position even further separated from that lens, which is clearly the inappropriate modification of actual claim language relied on.

First of all, the question is the distance a first lens travels relative to a second lens as it moves in a periodic cycle of overall movement. The interpretation offered includes nothing that can be reasonably said to be a cycle as to the simple linear movement of the first lens from a first point (a distance d_2 from the second lens) to a second point (a distance d_1+d_2 from the second lens).

Moreover this attempted over simplification of the actual claim language ignores the clear claim language requiring that the distance moved by the first lens in its "cycle" of movement relative to the second lens must be "longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens" where this "cyclic movement" of "at least one of said first lens and said second lens" has already been recited by these claims as being the result of the movement "by said moving means." The movement of the first lens away from the second lens of Maeda is still d_1+d_2 and d_1+d_2 cannot be greater than itself.

As has been previously emphasized to the PTO, it is clear error to fail to take each and every word of a claim into account in determining the subject matter thereof. See In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

Furthermore, and as fully discussed in the amendment filed July 29, 2002,

the meaning of "cycle" is well understood to be "an interval of time during which a sequence of a recurring succession of events or phenomena is completed" see Meridian Webster's Collegiate Dictionary, 10th Edition", 1996, page 288. As this page of this standard dictionary further indicates, it is well understood that cyclically is an adverb describing something as being related to a cycle. Thus, it is unmistakable that for anything to be reasonably

described as cyclical, some parameter thereof must be shown to be recurring in a repetitive sequence.

The clear meaning of “cycle” to even the layperson notwithstanding, the PTO once again would either erroneously read this word out of the rejected claims or apply an interpretation completely outside the boundaries of reason in order to improperly reject Claims 1, 5, 15, 19, 22, and 26 as being anticipated by Maeda.

Not only does the outstanding Action commit clear error by ignoring the word “cycle” or applying a totally unreasonable interpretation to it as to the above noted claim language, it also continues to improperly ignore it or unreasonably interpret it as to the claimed moving means that must “cyclically” move at least one of the first lens and second lens in an optical axis direction. As the amendment filed July 29, 2002, further noted:

As a sequence of a recurring succession of movement values is the key requirement to reasonably describing any movement to be cyclic, a showing of how Maeda teaches such a recurring succession of movement values is needed to support this rejection. However, the outstanding Office Action makes no attempt to point out where in Maeda such a teaching is to be found contrary to PTO reviewing court requirements (see In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”)). Thus, the outstanding Office Action is deficient in relying on the focus control movement of Maeda that is entirely dependent upon detected focus conditions relative to a particular medium with no guaranty of any recurring movement sequences.

Furthermore, while the United States Patent and Trademark Office is to give claim language its broadest reasonable interpretation, it is well established to be unreasonable to attempt to interpret words well understood by the artisan in a completely unrealistic manner. See In re Cortright, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Thus, simply reading the cyclical optical axis direction movements required by Claims 1, 15, and 22 on any focusing movement made in the optical axis direction is a clearly improper and erroneous interpretation. Accordingly, while cyclical may be a broader recital than one reciting the preferred sine wave movement (note Figure 6A, for example), it still require some form of cyclical movement not met by the

simple focus control movement of Maeda.

Besides the fact that Maeda neither teaches nor suggests any cyclical movement for the two-group objective lens in the direction of the optical axis as noted above, it also neither teaches nor suggests any use of reproducing signals obtained from the recording medium at one or more points of this cyclic movement as these claims also require. Once more the limitations positively set forth by Claims 1, 15, and 22 have been improperly ignored in making the outstanding rejection.

Apparently realizing that much is missing in Maeda, the outstanding Action attempts to improperly rely on "the positional adjustment of lens based on reproducing signals such as tracking addresses is an inherent feature" as if it is reasonable to assume that it is impossible to have an optical information recording/reproducing apparatus not performing positional adjustment of a lens based on reproducing signals such as tracking addresses. This is clearly not the case and the assumptions made in the outstanding Action as to inherency merely relating to one possibility are again clearly erroneous. As further explained in the amendment filed July 29, 2002, inherency cannot be established absent a showing that something must absolutely occur, not simply that something might possibly occur. Thus, in order to establish inherency, the PTO reviewing court in In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) has noted that the evidence:

[M]ust make clear that the missing descriptive matter is necessarily present in the thing described in the reference, that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Thus, before there can be said to be any inherency in positioning lenses on the basis of a reproducing signal or reproduced tracking addresses, it must be clear that no other manner of positioning a lens for such an apparatus was known. Clearly, as many lens

positioning techniques are and were used for focus correction that do not require any “positional adjustment of a lens based on reproducing signals such as tracking addresses,” the reliance on inherency is without merit¹.

Accordingly, for all the above-noted reasons, the rejection of base independent Claims 1, 15, and 22 as being anticipated by Maeda is respectfully traversed.

With regard to Claim 5 dependent upon Claim 1, Claim 19 dependent upon Claim 15, and Claim 26 dependent on Claim 22, each of these dependent claims clearly defines over anything reasonably taught or suggested by Maeda for the same reasons as the respective parent claim does. In addition, each of these dependent claims includes further features in addition to those recited by its respective independent claim, which added features are further not taught or suggested by Maeda. Thus, these dependent Claims are believed to patentably define over Maeda for this reason as well.

Turning to Claims 2, 3, 6, and 7, it is noted that these claims all depend on Claim 1. In addition, it is noted that Funada in no way cures any of the above-noted Maeda deficiencies. Accordingly, Claims 2, 3, 6, and 7 are believed to patentably define over Maeda considered alone or in any proper combination with Funada for at least the reasons that parent Claim 1 does. In addition, each of Claims 2, 3, 6, and 7 adds further features not taught or suggested by Maeda and/or Funada considered alone or together in any proper combination. Therefore, Claims 2, 3, 6, and 7 are further considered to patentably define over Maeda and/or Funada considered alone or together in any proper combination because

1. See, for example, Greve et al U.S. Patent No. 4,135,207 at col. 4, lines 12-35 that use spot symmetry relationships to indicate the need for focus correction, not track addresses. This reference was attached to the amendment filed February 19, 2003.

of these added features. Note, for example the required “low band filter” of Claim 6 or “high band filter” of Claim 7..

Page 10 of the outstanding Action attempts to once again erroneously interpret rectifier 35 of Funada as something that the artisan would interpret to be a filter. However, a filter and a rectifier are clearly understood to be different elements performing entirely different functions. A filter passes certain frequencies of an input signal while rejecting other frequencies of that input signal. A rectifier is a diode like device that converts alternating current (ac) to direct current (dc).

Moreover, the rectifier 35 of Funada does not even “rectify” the information (reproduced) signal from 33. In this regard, Funada does not teach DC offset to have any thing to do with the envelope of the reproduced information from 33, it comes from battery 38 when switched by 37 and is added to a completely different focus error signal from split-beam detector 41 that is different from the detectors 42 and 43 providing inputs to 33 to provide the reproduced information signal.

With further regard to Claims 16, 17, 20, and 21 it is noted that each of these claims depend from Claim 15 such that they clearly patentably define over Maeda for the same reasons that parent Claim 15 does. In addition, it is again noted that Funada in no way cures the above-noted deficiencies in Maeda as fully discussed above. Accordingly, Claims 16, 17, 20, 21, are believed to clearly patentably define over Maeda taken alone or with Funada in any proper combination for all the reasons discussed above as to parent Claim 15. In addition, each of Claims 16, 17, 20, and 21 further clearly patentably define over Maeda taken alone or in any proper combination with Funada because of the features that each of

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these claims add to independent base Claim 15. Note again the added high and low band filters of Claims 20 and 21.

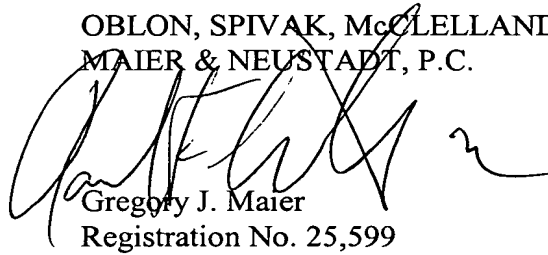
Turning to Claims 23, 24, 27 and 28, it is noted that each of these claims depends from base independent Claim 22. Again, as Funada cures none of the deficiencies noted above as to Maeda and base independent Claim 22 clearly patentably defines over these references taken alone or in any proper combination, so do these claims dependent thereon. In addition, these dependent claims add further features to base independent Claim 22 and these features also clearly patentably define over anything reasonably taught or fairly suggested by either Maeda taken alone or in any proper combination with Funada.

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In light of the foregoing and as no other issues are believed to remain outstanding relative to this application, it is respectfully submitted that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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